

REMARKS

This proposed Amendment is being filed prior to payment of the issue fee in Application No. 09/900,927. See 37 C.F.R. § 1.312.

The Present Application is a divisional of Application No. 09/521,810 (“Parent Application”) as indicated on the “Utility Patent Application Transmittal” for the Present Application, filed on July 9, 2001.

The Applicants respectfully request entry of the proposed Amendment and correction of the Filing Receipt to reflect the claim for priority to the Parent Application, as available under 35 U.S.C. §§ 120 and 121.

As grounds for the request, the Applicants state as follows:

1. The Parent Application (Serial No. 09/521,810) titled “Quilting Method and System” was filed on March 9, 2000 by the law firm Andrus, Sceales, Starke & Sawall, LLP on behalf of the named inventors Jilene A. Repp and Francis A. Yogerst (the Applicants).

2. In an Office Action mailed on February 8, 2001, the Examiner made a restriction requirement between Group I (Claims 1-14) and Group II (Claims 15-20) in the Parent Application.

3. In an Amendment filed on April 5, 2001, the Applicants confirmed the election of Claims 1-14, amended Claims 1-13, and stated that they “will cancel claims 15-20 on allowance of this Application subject to reserving the right to file a divisional application.”

4. The Parent Application including Claims 1-14 was allowed by the Examiner in a Notice of Allowance and Issue Fee Due mailed on April 27, 2001.

5. The Present Application (Serial No. 09/900,927) titled “Quilting Method and System” was filed on July 9, 2001 by the law firm Andrus, Sceales, Starke & Sawall, LLP on behalf of the named inventors Jilene A. Repp and Francis A. Yogerst (the Applicants).

6. The Present Application is actually a divisional of the Parent Application, sharing the same specification and originally presenting Claims 15-20 that had been cancelled in response to a restriction requirement in the Parent Application.

7. The Present Application was filed on July 9, 2001 with a Utility Patent Application Transmittal (form OMB 0651-0032) stating that the present Application is a “Divisional ... of prior application No. 09/521,810.” See Exhibit A. A Preliminary Amendment was also filed on July 9, 2001 stating that the Present Application is a “Divisional of Serial No. 09/521,810 Filed: 03/09/2000,” the Preliminary Amendment also gave instructions to “cancel claims 1-14.” See Exhibit B.

8. U.S. Patent No. 6,261,397 issued from the Parent Application on July 17, 2001.

9. A Filing Receipt for the Present Application mailed on August 8, 2001 did not include an entry under “Domestic Priority data as claimed by applicant” for priority as a divisional of the parent Application, notwithstanding that the Present Application was identified as a divisional of the Parent Application in the transmittal of the Present Application.

10. A Petition to Advance Examination was filed by the Applicants on November 26, 2001. The Petition stated that the Present Application “is assigned to June Tailor, Inc., 2861 Highway 175, Richfield, Wisconsin 53076, and is a divisional application of Serial No. 09/521,810, now U.S. Patent No. 6,261,397, issued July 17, 2001.” See Exhibit C.

11. A Declaration of Minh Nguyen (of the law firm Andrus, Sceales, Starke & Sawall, LLP) was also filed by the Applicants with the Petition to Advance Examination filed on November 26, 2001. The Declaration stated “this application is a divisional of Serial No. 09/521,810, now U.S. Patent No. 6,261,397, issued July 17, 2001.” See Exhibit D.

12. A non final Office Action mailed on March 15, 2002 did not indicate that "acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121," notwithstanding that the Present Application was identified as a divisional of the Parent Application in the transmittal of the Present Application.

13. On June 17, 2002, the law firm Andrus, Sceales, Starke & Sawall, LLP transferred the file for the Present Application to the law firm Foley & Lardner, as instructed by the Assignee (June Tailor, Inc.).

14. On October 24, 2002, Foley & Lardner filed a Revocation of Prior Powers of Attorney by Assignee, Appointment of New Power of Attorney by Assignee, and Change of Correspondence Address. Foley & Lardner continued the prosecution of the Present Application on behalf of the Applicants.

15. A Notice of Allowance and Fee(s) Due for the Present Application was mailed on October 7, 2003.

16. Upon review of the Present Application in preparation for payment of the issue fee, Foley & Lardner first noticed that the claim of priority to the Parent Application had not been acknowledged by the U.S. Patent and Trademark Office for the Present Application.

17. A copy of the Utility Patent Application Transmittal (form OMB 0651-0032) stating that the Present Application is a "Divisional ... of prior application No. 09/521,810" (a proper claim for the benefit of priority under 35 U.S.C. §§ 120 and 121 and 37 C.F.R. § 1.78) is provided. See Exhibit A.

18. The Applicants have now submitted a proposed Amendment to the Specification of the Present Application under 37 C.F.R. § 1.312 to include a reference to the Parent Application, indicating the relationship of the Present Application as a divisional of the Parent Application.

19. The Amendment to the Specification provides a reference identifying the Present Application as a divisional of the Parent Application, Application No. 09/521,810,

filed on March 9, 2000. See 37 C.F.R. § 1.78(a)(2)(i).

20. As shown in the transmittal and Preliminary Amendment, from the date of filing of the Present Application, the Applicants intended to make a claim of priority to the Parent Application in the Present Application. Any failure to amend the Present Application to contain a reference to the Parent Application that may have occurred was unintentional.

21. The Applicants respectfully request entry of the Amendment under 37 C.F.R. § 1.312 and the issuance of a corrected Filing Receipt to show the claim for domestic priority to the Parent Application, as made by the Applicants in the Utility Patent Application Transmittal filed concurrently with the Present Application.

22. A Petition to Advance Examination filed by the Applicants on November 26, 2001 was granted. See Decision on Petition Under M.P.E.P. § 708.02 mailed on February 5, 2002. Accordingly, the Applicants respectfully request that this Request be handled with special dispatch.

The Applicants believe that no petition under 37 C.F.R. § 1.78(a)(3) is required and no petition fee or other fees are due in connection with this Request for Amendment under 37 C.F.R. § 1.312. In the event that this belief is not correct, the undersigned authorizes the Commissioner to proceed under 37 C.F.R. § 1.78(a)(3) and to charge Deposit Account No. 06-1447 for any petition fee.

Respectfully submitted,

Date OCTOBER 17, 2003

By



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